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EXAMINER

QUAN, ELIZABETH S

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,399

Applicant(s)

HAHS ET AL.

Examiner

Elizabeth Quan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1-3 and 8 is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to the apparatus of a cassette assembly for delivering a substance, classified in class 422, subclass 102.
 - II. Claims 9-13, drawn to the method for supplying a cassette encased in a sleeve for a machine, classified in class 436, subclass 43.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as packaging for different products—pizza boxes, cigarette cartons, light bulb containers, or tray holders.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Andrew Farmer on 5/20/2002 a provisional election was made with traverse to prosecute the invention of I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-13 are withdrawn

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from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

6. The drawings are objected to because line 5-5 has not been indicated in FIG. 1, which is the basis of FIG. 7. Additionally, claimed elements, such as the first end of the cassette and sleeve, first edge of the sleeve, first face of the cassette, retaining member, and first and second lateral edges. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. Figures 1-3, 9, and 10 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). These figures are included in U.S. Patent No. 4,817,800 to Williams et al., U.S. Patent No. 5,882,611 to Williams et al., and U.S. Patent No. 5,887,716 to Williams et al. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: (32). A proposed

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drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: (46), (48), (52), (54), (56), (58), (60), (64), and (108) in FIG. 4; (62) in FIG. 5; and (48), (62), and (64) in FIG. 6. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

10. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

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11. The abstract of the disclosure is objected to because it does not provide substantial technical disclosure of the improvement of the cassette and delivery system--the sleeve.

Furthermore, the abstract should briefly set forth a process for making the sleeve. Correction is required. See MPEP § 608.01(b).

12. The disclosure is objected to because of the following informalities: On page 2, line 2 "deliver" should be replaced by "delivery." On page 2, line 17 "so" should be replaced by "to." On page 3, line 25 "supplys" should be replaced by "supplies." On page 4, line 1 "the" should be inserted between "between" and "first and second sides thereof..." On page 8, line 23 before "departing from the spirit of the invention" "the" should be omitted. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Objections

13. Claim 1 is objected to because of the following informalities: In line 10 "the cassette's first side" should be "the first side of the cassette." In line 12 "the cassette's second side" should be "the second side of the cassette." In the last two lines of the claim "the sleeve second side" should be "the second side of the sleeve." Appropriate correction is required.

14. Claim 2 is objected to because of the following informalities: In the third line from the bottom of the claim "the sleeve first edge" should be "the first edge of the sleeve" and "the cassette first face" should probably be "the first face of the cassette." Appropriate correction is required.

15. Claim 3 is objected to because of the following informalities: In the second line of the claim "the sleeve first side" should be "the first side of the sleeve." In the last two lines of the

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claim "the sleeve second side" should be "the second side of the sleeve." Appropriate correction is required.

16. Claim 8 is objected to because of the following informalities: In the first line of the claim "identifying" should probably be "an." Appropriate correction is required.

Claim Rejections - 35 USC § 112

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1-8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the location and orientation of the first end with respect to the first and second sides of both the cassette and protective sleeve, first lateral dimension and first end of the protective sleeve, second lateral dimension and first end of the sleeve, first edge and first end of the protective sleeve, first and second lateral edges with first and second lateral dimensions of the protective sleeve, first and second lateral edges with first edge of the protective sleeve. It is difficult to construct an accurate picture of the protective sleeve with respect to the cassette without the exact locations and orientations of the structural elements with respect to each other. Confusion sometimes arises when both the protective sleeve and cassette have identically labeled elements, such as first side, second side, and first end. Additionally,

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distinction between the sleeve enveloping the cassette and the protective sleeve located at the end of the enveloping sleeve is difficult from the claim language. The Applicant appears to claim only the protective sleeve of the enveloping sleeve. It is unclear from claim 1 how the first and second tabs are at the first end. First end has been interpreted as an open end of the enveloping sleeve.

20. Claims 3-8 are rejected based on their dependency on base claims.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

24. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,882,611 to Williams et al. in view of U.S. Patent No. 3,828,922 to Holkestad.

Referring to claims 1, 2, 4, 5, 7, and 8, Williams et al. discloses a cassette assembly (20) for delivering a substance (see ABSTRACT; FIGS. 1, 2, and 13). The cassette (24), which comprises a first side, second side opposite the first side, first face between its first and second side, and a first end, has at least one cell (32) containing a quantity of the substance (see ABSTRACT; FIG. 2; COL. 4, lines 46-67). Williams et al. disclose an enveloping sleeve (22) made from absorbent cardboard with an open end (23), closed end (25), outer layer (28), and inner layer (26), which wraps about the cassette (26) (see ABSTRACT; FIGS. 1 and 2; COL. 2, lines 31-38; COL. 3, lines, 6-9; COL. 4, lines 49-52; COL. 5, lines 1-6 and 43-48). The sleeve (22) has an indicator, preferably in the form of a moveable label, for indicating a used cassette (see COL. 2, lines 11-14). The cassette assembly (20) has identifying indicia (72) on the cassette (24) and an aperture (74) in registry with the indicia allowing the indicia (72) to be read through the aperture (74) (see FIGS. 1-5 and 13; COL. 5, lines 18-34). However, they do not explicitly disclose a protective sleeve at an open end of the enveloping sleeve (22). However, Holkestad discloses an enveloping sleeve (12) for enclosing cassette (52) comprising a protective sleeve (14) at an open end of the enveloping sleeve (12) with a first side, second side opposite the first side, and first end (see FIGS. 1-5). The protective sleeve (14) has a first tab (20) at the first end, which extends inwardly from the first side

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toward the second side and abuts the cassette's first side, and a second tab (16) at the first end, which extends inwardly from the second side toward the first side and abuts the cassette's second side (see ABSTRACT; FIGS. 1-5; COL. 2, lines 30-36 and 64-68; COL. 3, lines 1-19 and 57-68; COL. 4, lines 1-27). The cassette (52) has a first lateral dimension (53) between its first and second sides smaller than a second lateral dimension between the sleeve's first and second side, and the protective sleeve (14) has a retaining member connected to the sleeve (14) by a hinge (31) at the sleeve's first edge and abuts the cassette's first face (see ABSTRACT; FIGS 1-5; COL. 2, lines 45-50; COL. 3, lines 41-45). The first and second tabs (20,16) extend inwardly from respective first and second lateral edges of the retaining member (see ABSTRACT; FIGS. 1-5; COL. 2, lines 30-36 and 64-68; COL. 3, lines 1-19 and 57-68; COL. 4, lines 1-27). The configuration of the protective sleeve allows inserting the cassette into the enveloping sleeve while preventing easy withdrawal of the cassette from the sleeve. Therefore, it would have been obvious to modify the cassette assembly of Williams et al. to include the protective sleeve of Holkestad to prevent easy withdrawal of the cassette from the sleeve as well as locking the cassette into place.

Referring to claim 6, Williams et al. do not explicitly disclose cassette assembly with the sleeve made from coated cardboard. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cassette assembly of Williams et al. to make the sleeve from coated cardboard to increase the absorbance and strength of the sleeve to prevent the operator from contacting the sterilant and the sleeve from tearing.

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25. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,882,611 to Williams et al. and U.S. Patent No. 3,828,922 to Holkestad as applied to claims 1,2, and 4-8 above, and further in view of U.S. Patent No. 3,933,240 to Humble.

Referring to claim 3, Williams et al. in view of Holkestad do not disclose the first and second tabs each comprising at least one flap folded inwardly toward the sleeve's first and second sides, respectively. However, Humble discloses at least one flap (46,48) for each of the tabs (36) bent inwardly toward the sleeve's first and second side (see ABSTRACT; FIGS. 1 and 2; COL. 2, lines 52-66). The tabs fix the cassette in the container and prevent unauthorized and inadvertent removal of the cassette from the container (see ABSTRACT; FIGS. 1 and 2; COL. 3, lines 44-68; COL. 4, lines 1-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cassette assembly of Williams et al. to include at least one flap for each of the tabs bent inwardly toward the sleeve's first and second sides to fix the cassette within the container and prevent unauthorized and inadvertent removal of the cassette from the container.

26. Alternatively, claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,882,611 to Williams et al. as applied to claims 1, 2, and 4-7 above, and further in view of U.S. Patent No. 5,869,341 to Woodaman and U.S. Patent No. 5,976,881 to Klingner.

Referring to claims 7 and 8, Williams et al. disclose the cassette assembly (20) with identifying indicia (72) on the cassette (24) and an aperture (74) in registry with the indicia, allowing the indicia (72) to be read through the aperture (74) (see FIGS. 1-5 and

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13; COL. 5, lines 18-34). While Williams et al. also disclose an indicator for indicating when the cassette has been used, they do not explicitly disclose an indicator for indicating the presence of substance on the cassette. However, it is well known to provide an indicator on an article, such as a cassette within a sleeve, for indicating the presence of a contaminant on the sleeve as evidenced by Woodaman and Klingner. Woodaman disclose a food contamination detector comprising an indicator bound to a substrate (see COL. 2, lines 11-25). Klingner disclose detectors disposed on a gloved for detecting predetermined contaminant chemical or chemicals being handled or used by the user (see ABSTRACT; FIGS. 1 and 7; COL. 3, lines 16-26). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cassette assembly of Williams et al. to include an indicator for monitoring the presence of a substance as in Woodaman or Klingner as a safety measure against operator's contact with contaminants.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art includes one or more limitations recited in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 879-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan
Examiner
Art Unit 1743

eq
June 17, 2002

A handwritten signature in cursive script, reading "Arlen Soderquist".

ARLEN SODERQUIST
PRIMARY EXAMINER